

REMARKS

The application presently contains claims 1-3. In the Office Action mailed 02 December, 2005 the Examiner required restriction to one of the following groups under 35 U.S.C.121 (*see* instant Office Action, page 2):

Group I: “Claim 1, drawn to a polynucleotide, classified in class 536, subclass 23.1.”

Group II: “Claim 2, drawn to a polypeptide, classified in class 530, subclass 300.”

Group III: “Claim 3, drawn to a method for producing a recombinant plant, classified in Class 800, subclass 278.”

In the instant Office Action, the Examiner also required under 35 U.S.C.121, to elect one SEQ ID NO. upon election of any one of the Groups.

Applicants respectfully traverse the restriction requirement, and provisionally elect Group II. In response to the sequence election requirement, Applicants also provisionally elect, with traversal, polypeptide SEQ ID NO: 44293.

Applicants note that polynucleotide sequence SEQ ID NO: 12729 would encode the polypeptide sequence elected above. For reasons more fully described below, it is respectfully requested that this sequence also be part of this election.

Applicants respectfully traverse the Examiner’s assertion (see instant Office Action, Page 2, paragraphs 6) that,

“Inventions of groups I and II are patentably distinct products.”

We traverse by invoking the central dogma of biology which defines that a polypeptide is an expressed polynucleotide. As specified in instant Application, each polypeptide, identified by its SEQ ID NO identifier, is related to its corresponding, expressed polynucleotide, identified by its SEQ ID NO identifier. Applicants contend that, at least, Groups I and II should be examined simultaneously because they are related as nucleic acids and proteins encoded by such nucleic acids.

Applicants submit that the complete examination of the application would be handled most expeditiously by treating pending claims 1-3 as a single entity. As Section 803 of the MPEP directs, “[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” Applicants respectfully submit that the Examiner has not shown that a search and examination of the entire application, or more than one sequence, would cause a serious burden. Rather, a serious burden would arise if the application were restricted. The Examiner’s argument for serious burden is two-fold and is traversed together.

First (see instant Office Action, Page 2 paragraph 8), the Examiner states,

“the search of the polypeptides and the polynucleotides are not coextensive”... “the sequences are searched in appropriate databases.”

Second (see instant Office Action, Page 2 paragraph 8), the Examiner states,

“Prior to the concomitant isolation and expression of the sequence of interest there may be journal articles devoted solely to the

polypeptides which would not have described the polynucleotide.

Similarly, there may have been “classical” genetics papers which had no knowledge of the polypeptide but spoke to the gene.”

Applicants contend that a coextensive search is possible when appropriate databases and search algorithms are used. Furthermore, Applicants submit that a concomitant search of the polypeptide and its expressed polynucleotide is proper, as a matter of diligence, especially if there may have been articles or papers that describe only half the story. Therefore, an election of Group I or an election of Group II, whatever the case might be, would duly oblige the Examiner to perform a concomitant search of the literature for sequences from both Groups. Applicants contend that to separate Groups I and II into separate claims would be a mistake, a mistake similar to the hypothetical (but believable) articles or papers described by the Examiner that publish only half the story. Moreover, a search for claim 3 (Group III), which encompasses the product, would concomitantly include a search of the sequence of claim 1 (Group I) and claim 2 (Group II). Accordingly, an examination of at least Groups I and II (claims 1-2) and preferably all three (I-III) pending groups (claims 1-3) together ought to be necessary by the Examiner. Therefore, Applicants respectfully request a reconsideration to examine all three (3) pending claims together, that is, the elected polypeptide sequence SEQ ID NO: 44293 with its associated polynucleotide sequence SEQ ID NO: 12729 in a plant having an improved property.

Applicants respectfully traverse the arguments the Examiner has put forth regarding the product and process of use as in MPEP § 806.05(h) (see instant Office Action, Page 3, paragraph 2) as the Examiner states,

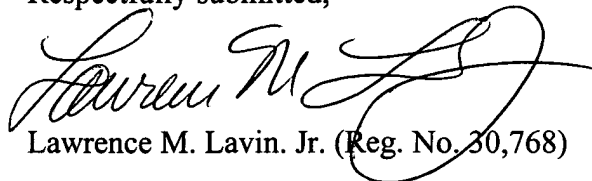
“Inventions of groups III and I or II are related as product and
process of use.”

We traverse because the product being claimed here is “a plant having an improved property” and therefore, the methods of claim 3 is dependent on the polynucleotide and polypeptide of claims 1 and 2 to make the product described in claim 3. Applicants submit that a provisional election to amino acid sequence SEQ ID NO: 44293, fully supports the method of claim 3. More specifically, we have data from recombinant plants expressing a polypeptide of SEQ ID NO: 44293 having an improved property of cold tolerance. Therefore, Applicants respectfully request a reconsideration to examine all three (3) pending claims together.

Based upon the foregoing, Applicants submit that the restriction requirement is improper and therefore should be withdrawn. Applicants reserve the right to prosecute non-elected groups of claims in future divisional applications.

Should the Examiner have any questions regarding this application, the Examiner is encouraged to contact Applicants' undersigned representative at (314) 694-3602.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Lawrence M. Lavin, Jr.", written in black ink.

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